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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,670	06/10/2005	Pil-Soo Han	1338-7 (PCT-EK-05-01)	6008
28349 7590 03/31/2009 DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. SUITE 702 UNIONDALE, NY 11553				
EXAMINER FEENEY, BRETT A				
ART UNIT		PAPER NUMBER		
4114				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,670

Applicant(s)

HAN, PIL-SOO

Examiner

BRETT FEENEY

Art Unit

4114

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Detailed Action

Status of the Claims

1. The following is a Non-Final office action.
2. This office action is in response to application 10/538670 filed on 06/10/2005.
3. Claims 1 – 7 are currently pending and have been examined.

Rejections under § U.S.C. 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not enabled in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, could practice the claimed invention. Claim 2 recites "a contribution degree calculation unit". In the instant case, a calculation unit appears to be a program, algorithm or process for calculating the contribution of an athlete on its face. However, there are no steps recited in the claims for how a person or a machine practicing this invention would perform this calculation. Further, the present disclosure does not present how the invention would be practiced with conventionally constructed models, programs or algorithms and therefore encompass any and all calculation units or acts for performing the recited function. The above recitations fail to imply the presence of any apparatus, as they fail to serve structural limitations because they are not "means" recitations subject to interpretation under 35 U.S.C. §112 sixth paragraph, and would not have been understood in the art as implying any particular structure. Therefore, claim 2 is treated as encompassing any and all means for performing the recited functions and are accordingly rejected under 35 U.S.C. §112 first paragraph, based on a

nonenabling disclosure (*Ex parte* Miyazaki, 89 USPQ2d 1207). Because the claims encompass any and all means for performing the recited functions they are interpreted to read on any and all models known now, and in the future; without any recitation of the specific elements of the models and how one would practice the invention with said models. As such, "the disclosure fails to provide a scope of enablement commensurate with the scope of the claim and the claim would violate the prohibition of *Halliburton [Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946)]*."

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 – 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 – 7 are replete with the same errors. The Examiner has specifically pointed out exemplary errors, however, Applicant is required to make correction to all the claims.
- Claim 1 recites "attack addition (contribution), attack subtraction (error), defense addition (contribution) and defense subtraction (error)". Claims can not contain language in parentheses that further limit the scope of the limitations in the claim. In the instant case, it is not clear if the how the additions and subtractions are determined and what defines a contribution and error. The Examiner has interpreted attack and defense additions and subtractions to refer to a number or qualitative metric.
 - Claim 1 recites "degree of contribution", which is a relative term. There is no special definition provided in the specification, nor is "degree of contribution" a term of art. One of ordinary skill in the art would not know what constitutes a degree of contribution nor how it is determined. The Examiner has interpreted a "degree of contribution" to refer to a number.
 - Claim 1 recites "setting 129 game factors based on the classified factors, setting the game factors to detailed 1277 game situation factors". It is not clear what "1277 game situation factors" and

"129 game factors" Applicant is referring. The factors have not been clearly defined nor are they terms of art. The Examiner has interpreted game factors to refer to numbers.

- Claim 1 recites "sending quantitative results to a corresponding server or terminal if the user". However there is no step of quantifying results recited in the claim. The Examiner has interpreted this limitation to refer to sending the aforementioned numbers to a user terminal.
- Claim 1 recites "the professional athletes, the scout of amateurs and mercenary scout, the athlete draft, the athlete trade, etc.,". The use of the word etcetera (etc.) renders a claim indefinite as one can not interpret the meets and bounds of the limitation. The Examiner has therefore interpreted this limitation to refer to a person.
- Claim 1 recites "baseball-related institute". It is unclear what Applicant intends by "baseball-related". One could interpret baseball-related to refer to a company that manufactures baseball equipment, a company that advertises at sporting events, a little league team, etc. The Examiner has interpreted baseball-related to refer to an institute.
- Claim 1 recites "authenticated by the financial institute/credit card company/mobile communication company billing server". It is not clear whether all of the aforementioned institutes' servers need to authenticate or if only one of the group of institutes' servers are required for authentication. The Examiner has interpreted the claim such that only one authentication from one of the servers is required.
- Claim 2 recites "an 1277 game situation factor unit". It is unclear what "an 1277 game situation factor unit" is as it is not specially defined in the specification, nor is it a term of art.
- Claim 2 recites "contribution portions such as". It is unclear what Applicant means by portions. It may mean part of the total contribution or only including some of the factors in that part of the contribution. Further, Applicant gives examples of what may be considered portions by reciting "such as", however, examples do not limit the claim. The examiner has therefore, interpreted the contribution portions to refer to numbers.
- Claim 2 recites "a member information database (DB) for storing and managing members; an athlete contribution degree database (DB)". It is unclear whether the (DB) in parentheses is

referring to the same database or different databases, one for member information and one for athlete contribution. The examiner has interpreted (DB) to refer to a common database.

- Claim 2 refers to "a game factor unit". A "game factor unit" does not mean anything on its face. A "game factor unit" is not a term of art, nor is it specially defined in the specification. The Examiner has interpreted a game factor unit to mean a number.
- Claim 2 refers to "a median setting unit". A "median setting unit" does not mean anything on its face. A "median setting unit" is not a term of art, nor is it specially defined in the specification. The Examiner has interpreted a median setting unit to mean a number.
- Claim 2 refers to "a contribution degree calculation unit". A "contribution degree calculation unit" does not mean anything on its face. A "contribution degree calculation unit" is not a term of art, nor is it specially defined in the specification. The Examiner has interpreted a contribution degree calculation unit to mean an algorithm, program or the like.
- Claim 3 recites "a member permission unit of the manager server to decide whether..." It is unclear how the manager server decides whether to allow or reject a member. There are no steps disclosed, rules defined or parameters for how allowing/rejecting member is performed. Therefore, it is unclear what Applicant intends to claim. One may interpret the claim such that the manager server is an automated program that filters members or it may simply allow a person (i.e Administrator) to accept or reject a member.
- Claim 4 recites "allowing a game factor unit within a manager server to set attack addition game factors of 41 items, attack subtraction game factors of 34 items, defense addition game factors of 30 items and defense subtraction game factors of 24 items;". The numbered items in the claims are not specially defined in the specification, nor are they terms of art. It is therefore unclear whether Applicant intends for the factors to be an exhaustive list of all factors that must be used in calculating the value of an athlete or if they are exemplary or optional factors that may be used in calculating the value of an athlete. The Examiner has interpreted these factors to be exemplary in nature and therefore interprets subtraction factors to be factors associated with negative numbers and addition factors to be factors associated with positive numbers.

- Claim 4 recites "game situation factor unit within the manager server to set game situation factors". It is unclear how the manager server sets the game situation factors. There are no steps disclosed, rules defined or parameters for how the server sets game situation factors. Therefore, it is unclear what Applicant intends to claim. One may interpret the claim such that the manager server is an automated program that sets factors due to predetermined rules or it may simply allow a person (i.e. an Administrator) to set factors manually. The same defects and rationale hold for "the median setting unit and the weight setting unit" recited in claim 4.
- Claim 4 recites *"and the defense subtraction game factors to (each game factor median*each game situation factor median)+400"*. This limitation does not make sense on its face. It is unclear whether Applicant is claiming that the *"game situation factors under the game situation principle for the attack addition game factors, the attack subtraction game factors, the defense addition game factors and the defense subtraction game factors"* are each set individually by applying the equation in parentheses or if all the factors are set to a single global equation. Further, one can not further limit a claim by adding further limitations in parentheses. The examiner has interpreted this claim such that all factors are applied to a single global equation that normalizes inputs.
- Claim 4 recites *"the weight, etc."*. The use of the word etcetera (etc.) renders a claim indefinite as one can not interpret the meets and bounds of the limitation. The Examiner has therefore interpreted this limitation to refer to a number.
- Claim 5 recites *"team member formation difficulty providing error subtraction 9"*. *"Team member formation difficulty providing error subtraction 9"* is not specially defined in the specification and is not a term of art. Therefore, it is unclear what Applicant is trying to claim. The Examiner has interpreted *"team member formation difficulty providing error subtraction 9"* to mean a number.
- Claim 6 recites *"the game situation factors for the items of the attack addition game factors, the items of the attack subtraction game factors, the items of the defense addition game factors, and the items of the defense subtraction game factors are divided into 7 items, 13 items, 21 items, 5 items, 9 items, 12 items and 4 items"*. It is not clear if how the items and factors are divided. For example, the 7 items could be the game situation factors for the items of the attack addition game

factors, the items of the attack subtraction game factors, the items of the defense addition game factors, or the items of the defense subtraction game factors. Further, there are 4 categories of factors claimed and 7 categories of items that are divided. Therefore, the claim does not make sense on its face. Moreover, the divisions of items are not in agreement throughout every limitation of the claim. For example, in one part of the claim the claim recites: *"the 7 items are contribution in disadvantageous point (over -7) situation"*, whereas in another part of the claim the claim recites: *"the 13 items are contribution in disadvantageous point (over -7) situation"*. The Examiner has interpreted the claim such that each of the factors includes a plurality of items associated with said factors.

- Claim 6 is replete with limitations in parentheses. Applicant is required to amend the claim such that all limitations are further defined in the body of the claim and not in parentheses. The Examiner has interpreted all limitations where there are a range of values assigned in parentheses to represent a number associated with the adjacent proceeding situation described in the claim.
- Claim 7 is replete with limitations that use the word etcetera (etc.). For example, claim 7 recites *"player ball clubs, etc."*. The use of the word etcetera renders a claim indefinite as one can not interpreted the meets and bounds of the limitation. The Examiner has therefore interpreted this limitation to refer to a person.
- Claim 7 is replete with limitations in parentheses. Applicant is required to amend the claim such that all limitations are further defined in the body of the claim and not in parentheses. The Examiner has not given any patentable weight to the additional words in parentheses.

Rejections under § U.S.C. 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 3 – 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
10. Claims 3 – 6 are directed to a method. However, the recited steps of the method are held to be non-statutory subject matter because the recited steps of the method are (1) not tied to another statutory class (such as a particular apparatus) or (2) not transforming the underlying subject matter (such as an article or materials) to a different state or thing.
11. Due to the rejections under §112 first and second paragraphs, the Examiner was unable to map prior art to the limitations in the claims as presently written.

Conclusion

12. The following patents and publications teach the elements of claims 1 – 7 and could be applied as prior art under relevant sections of §102 and §103. A general summary of the teachings of each patent and printed publication has been provided for the convenience of the Applicant.
 - Pearson et al., (US 5,018,736). The invention taught by Pearson discloses a system and method for valuing athletes based on performance. Further, Pearson teaches an interactive system for users for users to communicate information and access player and performance information.
 - Junkin (WO 9,737,734 A1). The invention taught by Junkin discloses a method and apparatus for evaluating the performance of players in a sporting event. The system and method taught by Junkin records statistics for player performance based on an individual contest and calculates a score for each player accordingly. Further, Junkin teaches using team statistics, in addition individual statistics for calculating a player score. Junkin teaches a plurality of inputs used to calculate a player's score including achievement, missed opportunities, outstanding performance and the like.
 - Holte (US 5,713,793). Holte teaches a system and method for calculating a value based on specific performance of players during a contest. Further, Holte teaches different valuations based thresholds of achievement and game situations.

Art Unit: 4114

- Gavriloff (US 6,371,855 B1). Gavriloff teaches a system and method for users to solicit and accept membership to a network involving valuation of athletes. The evaluation of athletes is based in part on value, points, game situations, position, demand for the player and performance. The athlete's value is consistently updated based on status, performance, situation analysis and the like.
- Del Prado (US 2004/0110552 A1). Del Prado teaches a system and method for valuing athletes based on position, performance, and the like. Further, Del Prado teaches a system and method for allowing a plurality of users to interact over a network.
- Dukes et al., (US 7,458,093 B2). Dukes teaches a system and method for authenticating users over a network of users and tracking the performance of an athlete or team.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Brett Feeney** whose telephone number is **571.270.5484**. The Examiner can normally be reached on Monday-Friday, 7:45am-5:15pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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16 March 2009

/BRETT FEENEY/